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PATENT

Attorney Docket No. NUCL-002/01US

Application No. 10/762,395

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Tony GIORDANO *et al.*

Confirmation No.: 4861

Application No.: 10/762,395

Group Art Unit: 1639

Filed: January 22, 2004

Examiner: J. Epperson

For: **Use of Post-Transcriptional Gene Silencing for Identifying Nucleic Acid Sequences that Modulate the Function of a Cell**

Commissioner for Patents  
U.S. Patent and Trademark Office  
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Randolph Building  
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Alexandria, VA 22314

**INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97(b)**

In accordance with the duty of disclosure set forth in 37 C.F.R. §1.56,  
Applicant(s) hereby submits the following information in conformance with 37 C.F.R. §§1.97  
and 1.98.

- ☒ Pursuant to 37 C.F.R. §1.98, copies of documents 71-556 cited in the attached Form PTO-1449 are enclosed on cd.
- ☐ Copies of the remaining publications listed on the attached Form PTO-1449 are not being provided pursuant to 37 C.F.R. §1.98(d) because the publications were previously cited by or submitted to the Office in prior Application Serial Nos.:  
to which the above-identified application claims priority under 35 U.S.C. §120.
- ☐ Copies of documents that were not submitted in the above-mentioned related United States Patent Applications may be found in related United States Patent Application Nos.:  
Should the Examiner be unable to locate a document, a copy will be provided upon request.
- ☒ No copies of any U.S. patents or U.S. patent application publications listed on the attached Form PTO-1449 are being provided pursuant to 37 C.F.R. §1.98.

- ☒ Applicants would also like to bring to the Examiner's attention *Benitec v. Nucleonics* Civil Action No. 04-CV-0174 (JJF) in the U.S. District Court for the District of Delaware. Documents 1-133, 135-143, 145-460 and 462-556 cited herein were first brought to the Applicants' attention in a search of literature related to this action.

**Should the Examiner wish to review any documents in Applicants' possession related to this action, the Examiner is invited to contact the undersigned and any documents requested will be forwarded.**

- ☒ Documents 38, 41, 125, 156, 196, 200, 206, 214, 217, 221, 309, 315, 343, 392 and 509 listed on the attached Form PTO-1449 were cited in an Opposition of EP 1230375 B1.
- ☒ Documents 134, 144 and 461 listed on the attached Form PTO-1449 were cited in a foreign search or examination report corresponding to Korean application serial no. 10-2001-7013385 and mailed on August 8, 2006. This application has inventors in common with the instant application.
- ☐ Enclosed is a copy of a non-English publication(s) \_\_\_\_\_. Pursuant to §609 of the M.P.E.P., Applicant submits the attached foreign search or examination report, which cites such non-English language publication(s).
- ☐ Enclosed is a copy of a non-English publication(s) \_\_\_\_\_. English language publication \_\_\_\_ (copy enclosed) claims priority from this non-English publication.
- ☒ An English translation of non-English document 551 is attached to the document. US patent 5,788,265, document 51, is being submitted as an English language equivalent of non-English document 107, EP 0 560 156 A2. An English abstract of non-English publications WO 92/19732 A1, WO 95/18223 A1, WO 98/05770 A2 and WO 00/44895 A1, documents 122, 131, 146 and 161 respectively, may be found on the cover page of the publication. An English abstract of non-English publications JP 09-110894 A and JP 09-227413 A, documents 115 and 116 respectively, may be found attached to the publication.
- ☐ The Examiner's attention is directed to related co-pending United States Patent Application Serial Nos.:

This Information Disclosure Statement is filed within any one of the following time periods:

- ☐ within three months from the filing date of this national application other than a CPA under 37 C.F.R. § 1.53(d);
- ☐ within three months from the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in this international application;
- ☒ before the mailing date of a first office action on the merits; or
- ☐ before the mailing of a first office action after the filing of a request for continued examination under 37 C.F.R. § 1.114.


It is respectfully requested that the Examiner consider the above-noted information and return an initialed copy of the attached Forms PTO-1449 to the undersigned. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 50-1283.

Dated: November 17, 2006

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Respectfully submitted,  
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<b>INFORMATION DISCLOSURE CITATION</b> (Use several sheets if necessary)				<b>Attorney Docket No.</b> NUCL-002/01US		<b>Application No.</b> 10/762,395	
PTO Form 1449				Applicants: Tony GIORDANO <i>et al.</i>		PAGE 1 of 34	
Filing Date: January 22, 2004				Group Art Unit: 1639			
<b>U.S. PATENT DOCUMENTS</b>							
Initial	Document No.	Date	Name	Class	Sub-Class	Filing Date	
	1.	US 2002/0086356 A1	07/04/2002	Tuschl <i>et al.</i>			
	2.	US 2002/0114784 A1	08/22/2002	Li <i>et al.</i>			
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	5.	US 2003/0027783 A1	02/06/2003	Zernicka-Goetz			
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	12.	US 2004/0022748 A1	02/05/2004	Ananthapadmanabhan <i>et al.</i>			
	13.	US 2004/0064842 A1	04/01/2004	Graham <i>et al.</i>			
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	24.	US 4,605,394	08/12/1986	Skurkovich			
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	26.	US 5,024,938	06/18/1991	Nozaki <i>et al.</i>			
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	33.	US 5,272,065	12/21/1993	Inouye <i>et al.</i>			
Examiner			Date Considered				
<b>Examiner:</b> Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

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<b>U.S. PATENT DOCUMENTS</b>									
Initial	Document No.	Date	Name	Class	Sub-Class	Filing Date			
	34.	US 5,283,184	02/01/1994	Jorgensen <i>et al.</i>					
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	37.	US 5,514,546	05/07/1996	Kool					
	38.	US 5,578,716	11/26/1996	Szyf <i>et al.</i>					
	39.	US 5,583,021	12/10/1996	Dougherty <i>et al.</i>					
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	43.	US 5,683,985	11/04/1997	Chu <i>et al.</i>					
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	47.	US 5,714,323	02/03/1998	Oshima <i>et al.</i>					
	48.	US 5,739,309	04/14/1998	Dattagupta <i>et al.</i>					
	49.	US 5,747,338	05/05/1998	Giese <i>et al.</i>					
	50.	US 5,795,715	08/18/1998	Livache <i>et al.</i>					
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	63.	US 6,291,504	09/18/2001	Nugiel <i>et al.</i>					
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	65.	US 6,372,965	04/16/2002	Lightner <i>et al.</i>					
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	127.	WO 95/03406 A2	02/02/1995	WIPO					
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	172.	WO 03/006477 A1	01/23/2003	WIPO					
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	177.	Agrawal <i>et al.</i> , "Antisense therapeutics: is it as simple as complementary base recognition?" <i>Molecular Medicine Today</i> 6:72-81 (2000).							
	178.	Agrawal <i>et al.</i> , "RNA Interference: Biology, Mechanism, and Applications" <i>Microb. Mot. Biol. Rev.</i> 67:657-685 (2003).							
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	182.	Akhtar <i>et al.</i> , "Anti-HIV therapy with antisense oligonucleotides and ribozymes: realistic approaches or expensive myths?" <i>J. Antimicrob. Chemother.</i> 38: 159-165 (1996).							
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